



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/585,573	06/02/2000	Hiroshi Tsumura	PM 270735/SH-0020US	9140

7590 12/02/2002
PILLSBURY WINTHROP LLP
1600 TYSONS BOULEVARD
MCLEAN, VA 22102

EXAMINER

VINCENT, SEAN E

ART UNIT	PAPER NUMBER
----------	--------------

1731

8

DATE MAILED: 12/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

mk-8

Office Action Summary	Application No.	Applicant(s)	
	09/585,573	TSUMURA ET AL.	
	Examiner	Art Unit	
	Sean E Vincent	1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-5 and 24 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by McMenamin (EP 040540). The features of applicant's claims can be found in the abstract, figure 1, and pages 5-11 (especially page 10, line 28 to page 11, line 18). Note the presence of control valve 26, temperature controller 48, flow controller 40 and pressure sensor 50 and the use of each.

Claim Rejections - 35 USC § 103

3. Claims 6, 7, 16-23, 25 and 27-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over McMenamin in view of Saitoh et al (US 5250097).
4. McMenamin does not elaborate on the "using system" to which the raw material vapors is sent. Saitoh et al teaches apparatus and methods of producing glass soot by hydrolyzing glass forming raw material using a burner (see figures, col. 2, line 10 to col.3, line 12). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to connect the vapor supply means of McMenamin to the hydrolyzing "using system" of Saitoh et al because the system of McMenamin was expected to be connected to a compatible deposition system and the system of Saitoh et al was expected to be connected to a compatible vaporization system. Neither reference specifies or excludes connected systems.
5. In the above combination, a circulating water cooling system in the reacting vessel is anticipated by Saitoh et al and vessel temperatures of 50°C to 150 °C were disclosed. Saitoh et

Art Unit: 1731

al does not teach placing anticorrosive or antiblastic chemicals in the circulating water. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to add such chemicals to a circulating water cooling system because coolant additives were well known in the cooling arts.

6. Claims 8-15 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over McMenamin and Saitoh et al as applied to claims 6 and 25 above, and further in view of JP 9-110457.

7. McMenamin and Saitoh et al fail to disclose a filter for the raw material gas supplied to the reaction vessel. JP 9-110457 teaches placing filters on all the gas feeds going into the furnace core tube including the raw material feed (see English abstract and figures 1 and 2). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to place a filter in the raw material feed line between the supply tank and the supply valve of McMenamin and Saitoh et al because JP 9-110457 taught that it would have removed harmful particles.

8. JP 9-110457 does not teach a filter type. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the claimed filter types because they would have been well known in the filtering arts.

Response to Arguments

9. Applicant's arguments filed September 13, 2002 have been fully considered but they are not persuasive

10. In response to the argument that McMenamin does not teach independent temperature and pressure control, the examiner disagrees. Firstly, where the apparatus claims are concerned, note that the manner or method in which a machine is to be utilized is not germane to the issue of patentability of the machine itself, see *In re Casey*, 152 U.S.P.Q. 235 (CCPA 1967). With regard to the method claims, the applicant's attention is drawn to page 10, line 28 to page 11, line 18 of McMenamin which outline separate temperature and pressure control steps.


11. In response to applicant's argument that Saitoh et al is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Saitoh et al was in the silica soot hydrolysis field of endeavor.

12. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., preventing clogs in a gas supply valve) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

14. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean E Vincent whose telephone number is 703-305-3607. The examiner can normally be reached on M - F (8:30 - 6:00) Second Monday Off.
16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P Griffin can be reached on 703-308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.
17. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.



Sean E Vincent
Primary Examiner
Art Unit 1731

S Vincent
November 26, 2002